

REMARKS

This application has been reviewed in light of the final Office Action dated October 11, 2006. Claims 1-15, 45, and 46 are presented for examination, of which Claims 1, 6, 9, 12, and 13 are in independent form. Claims 1, 6, 9, 12, and 13 have been amended to define still more clearly what Applicants regard as their invention. Favorable reconsideration is requested.

Applicants note that Information Disclosure Statements were filed on April 20, 2006, and January 16, 2007, and ask the Examiner, in due course, to consider and make of record the documents cited therein, and to provide Applicants initialed copies of the corresponding forms PTO-1449 with his next communication.

Before turning to the claims, Applicants note that they have requested and paid for a three-month suspension of prosecution, to ensure that they are able to schedule and conduct a telephone interview prior to the Examiner issuing his next action. In any event, Applicants hereby request such an interview.

Claims 1, 3-5, 6, 9, 11-13, and 15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Application Laid-Open No. JPA 09-244828 (*Akihiko*).

Independent Claim 1 is directed to a client apparatus for transmitting print data to a printer such that the printer prints out the print data and for performing user authentication processing in print processing. The apparatus includes a job combination unit, a request unit, and a transmission control unit. The job combination unit combines a plurality of print jobs into a single combined print job. The request unit, by means of a printer driver, issues a request, including an input user ID, to an authentication server for obtaining permission to print the single combined print job combined by the job combination unit. The transmission control unit

includes a printer driver for controlling a process so that, when permission is obtained from the authentication server, print data based upon the single combined print job is generated by means of the printer driver and transmitted to a printer. When permission is not obtained from the authentication server (i) the print data based upon the single combined print job is not generated by means of the printer driver and (ii) an indication that permission was not obtained from the authentication server is transmitted to a job accounting application by means of the printer driver.

By virtue of the features of the apparatus of Claim 1, the client apparatus communicates with a server by means of a printer driver to control authentication processing, and an indication that permission was not obtained from the authentication server is transmitted to an application by means of the printer driver.

As a result, authentication processing can be accomplished by means of a printer driver even if a printer to be used does not have an authentication function and an input function. Moreover, a print job is not transmitted to the printer when authentication fails. Thus, an efficient client apparatus is provided because print data is not generated by a printer driver when a user is not authenticated.

In the *Akihiko* system, when a job number is integrated with the last document being output, a print server 2 transmits that instruction to a printer 3. The printer 3 combines image data in a memory area of a user into a file and gives the file an integrated job number. The integrated job number is transmitted to the computer 1 via the print server 2 (12). The user inputs the integrated job number and a password through an operation panel 34 of the printer 3 (13). Alternatively, the password can be input by reading an IC card via the card reader. The printer 3 prints the image data stored in the memory based upon the input information (14). The

printer 3 erases the image data and the integrated job number after completion of printing the image data. (*Akihiko*, paragraphs [0024] and [0025]).

Akihiko apparently also provides that when a user instructs a computer 1 that transmitted data is not required to be printed (8), the computer 1 transmits an instruction to erase output data (9). That instruction is transmitted to the printer 3 via the print server 2. The printer 3 erases the job number, etc., from the image data processing unit 37 in response to the instruction (*Akihiko*, paragraph [0029]). When a user wishes to print data, the user inputs a job number and a predetermined password through the operation panel 3 or an ID card from the card reader (10). The printer 3 references a job number and information (a password or ID card information) stored in the image data processing unit 37 to authorize the input information. The printer 3 transmits a signal indicating that the printer can accept image data to the print server 2 if authorization is successful (11) (*Akihiko*, paragraph [0030]).

Therefore, as Applicants understand the apparatus of *Akihiko*, print data is generated even when authorization fails, unlike with the apparatus of Claim 1. The generated data in *Akihiko* is erased when authorization fails, whereas in the apparatus of Claim 1, print data is not generated at all if permission is not obtained from the authentication server. Also, unlike the apparatus of Claim 1, in *Akihiko*, an indication that permission was not obtained from the authentication server is not transmitted to the computer 1 even though an erase instruction is transmitted to the computer 1. Moreover, in *Akihiko* the password is input from the printer, not from a client terminal.

In the Office Action, the Examiner states “the applicant has confused two types of authentication.” Applicants do not understand this assertion. The Office Action states that “the claimed feature is inherent and obvious in all printing systems, for example in Microsoft

Windows 98..." (Office Action, page 2, paragraph 2). Applicants respectfully disagree that the features that are not expressly disclosed in *Akihiko* are nonetheless somehow inherently present in *Akihiko* and submit that the Office Action does not provide sufficient evidence or reasoning to support such an assertion.

While anticipation is not an *ipsissimis verbis* test, it is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). "In relying upon a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). Furthermore, to establish inherency, the extrinsic evidence

must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

MPEP § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added)).

Two notable features of the client apparatus of Claim 1 are (1) a request unit for, by means of a printer driver, issuing a request, including an input user ID, to an authentication server for obtaining permission to print the single combined print job combined by said job combination unit; and (2) a transmission control unit in which a printer driver controls a process so that, when permission is obtained from the authentication server, print data based upon the

single combined print job is generated by means of the printer driver and transmitted to a printer, but when permission is not obtained from the authentication server (i) the print data based upon the single combined print job is not generated by means of the printer driver and (ii) an indication that permission was not obtained from the authentication server is transmitted to a job accounting application by means of the printer driver.

Applicants respectfully submit that these features are not inherently found in *Akihiko*. The extrinsic evidence relied upon by the Examiner appears to be based on his personal knowledge of Microsoft® Windows 98®. While the Examiner alleges that certain features are found in Windows 98®, he has not met his burden of proof to show how the features that are not expressly found in *Akihiko* are necessarily present in *Akihiko*, which is the legal standard. Merely stating that “all printing systems” in the world contain the undisclosed features does not satisfy the legal burden of showing how the features are necessarily present in the cited reference. As stated above, in order for a claim to be anticipated under 35 U.S.C. § 102 all elements of the rejected claim must be found expressly or inherently in one prior art reference.

Furthermore, Applicants submit that the features alleged to be ubiquitous in printing systems by the Examiner are not expressly or inherently found in *Akihiko*. Applicants fail to understand how *Akihiko* could inherently disclose deliberately designed features that are the opposites of those of Claim 1. In the *Akihiko* system, a secret document is generated and transmitted from a host to a printer and stored in the printer even when the user is not authenticated. However, in the apparatus of Claim 1, a print job is not generated when the user is not authenticated. Furthermore, in the *Akihiko* system, in contradistinction to the apparatus of Claim 1, no indication that permission was denied by the authentication server is transmitted.

The Office Action does not provide a basis in fact or technical reasoning for asserting that the allegedly inherent claim elements are *necessarily* present in the teachings of *Akihiko* itself or that the allegedly inherent characteristic *necessarily* flows from the teachings of *Akihiko*. To the contrary, *Akihiko* does not expressly describe that (1) “a request unit for, by means of a printer driver, issuing a request, including an input user ID, to an authentication server for obtaining permission to print the single combined print job combined by said job combination unit;” or (2) “a transmission control unit in which a printer driver controls a process so that, when permission is obtained from the authentication server, print data based upon the single combined print job is generated by means of the printer driver and transmitted to a printer, but when permission is not obtained from the authentication server (i) the print data based upon the single combined print job is not generated by means of the printer driver and (ii) an indication that permission was not obtained from the authentication server is transmitted to a job accounting application by means of the printer driver”, as recited in Claim 1.

Therefore, Applicants respectfully request the Examiner (1) to provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of *Akihiko* itself, and (2) to show extrinsic evidence making clear that the missing descriptive matter is necessarily present in *Akihiko*.

Absent such showing, Applicants submit that Claim 1 is allowable over *Akihiko*.

Independent Claims 6, 9, 12 and 13 are directed to a method, storage medium, program, and system, respectively, corresponding to the apparatus recited in Claim 1, and are also believed to be patentable over *Akihiko* for at least the same reasons.

A review of the other art of record has failed to reveal anything which, in Applicants’ opinion, would remedy the deficiencies of the art discussed above, as a reference

against the independent claims herein. Those claims are, therefore, believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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